

Paper No. 9
RFC

THIS DISPOSITION IS NOT
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AUG. 11, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re TBAC Investment Trust

Serial No. 74/209,526

Philip T. Golden of Winstead Sechrest & Minick for TBAC
Investment Trust.

Rudy Singleton, Trademark Examining Attorney, Law Office
109 (Chris Pederson, Managing Attorney).

Before Cissel, Quinn and Wendel, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On December 6, 1996, applicant applied to register the
mark "EQUATOR" on the Principal Register based upon the
assertion of a bona fide intent to use it on "small leather
goods, namely, men's and ladies' belts, clutches, wallets,
key cases, credit/business card cases, purses and hand
bags," in International Class 18; and "clothing, namely

neckwear and men's and ladies' belts," in International Class 25.

The Examining Attorney refused registration under Section 2(d) of the Lanham Act on the ground that if applicant's mark were applied to the goods set forth in the application, it would so resemble two trademarks registered on the Principal Register that confusion would be likely. The two marks cited as bars to registration of applicant's mark are shown below.

The first one is registered for "watches."¹ The second is registered for "luggage and travelling bags."²

In support of the refusal to register, the Examining Attorney submitted print-outs from the Office records of a number of third-party use-based registrations wherein marks

¹ Reg. No. 1,967,036, issued to the Croton Watch Company, Inc. on April 9, 1996. First use and first used in commerce on May 4, 1964 were claimed.

² Reg. No. 1,829,849, issued on April 5, 1994 to Equator Group PLC, claiming first use and first used in commerce in July of 1993.

Ser No. 75/209526

are registered for both luggage and small leather goods of the type specified in the application, on the one hand, and

for both watches and items of clothing, including neckties and/or belts, on the other. The Examining Attorney explained to applicant that these third-party registrations show that applicant's goods are commercially related to the goods specified in the cited registrations, in that when similar trademarks are used on these kinds of products, consumers have a basis to expect watches and clothing items to come from the same sources, as well as a basis to expect the small leather goods specified in the application to emanate from the same places that offer luggage.

Applicant responded to the first Office Action by amending its application to delete reference to "men's and ladies' belts" in international Class 18, but leaving the reference to these goods in the proper class, Class 25, and presented arguments on the issue of likelihood confusion. Applicant contended that the commercial impression generated by its mark differs from the impressions the cited registered marks generate, and also argued that the goods in the cited registrations are substantially different from applicant's goods. In support of its argument that confusion would not be likely, applicant submitted the results of a computer search for trademarks incorporating the word "equator." Applicant did not submit

copies of the registrations listed in the report, but nonetheless argued that the search report establishes that the mark "EQUATOR" is weak in source-identifying significance.

The Examining Attorney was not persuaded by applicant's arguments, and although the amendment to the identification-of-goods clause was accepted, the refusal to register was made final.

Applicant timely filed a Notice of Appeal on January 21, 1998. Both applicant and the Examining Attorney filed briefs, but no oral hearing was requested by applicant. Accordingly, we have resolved in this appeal based on the written record and arguments presented in the application file and briefs.

Based on careful consideration of these materials, we find that the refusal to register is appropriate in this case.

The test for determining whether confusion is likely is set forth in detail in *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 13, 177 USPQ 563 (CCPA 1973). The factors identified therein which are relevant to the record in the instant proceeding are the similarity or dissimilarity of the marks in their entireties as to their appearance, sound, connotation and commercial impression; the

similarity or dissimilarity of the goods and their established, likely-to-continue trade channels; and the number and nature of similar marks in use on similar goods.

Contrary to applicant's contentions, these three marks are quite similar. Applicant's mark is the word "EQUATOR" in typed form, whereas the registered marks each present the same word in different stylized forms. Although applicant argues that the design components of the registered marks distinguish those marks so that confusion would not be likely with applicant's mark, a mark in typed form is not limited to any special form or style as displayed on the particular goods in question. The Philips Petroleum Co. v. J.C. Webb, Inc., 170 USPQ 35 (CCPA 1971). Although applicant argues as if these marks will be compared on a side-by-side basis, this is not necessarily the case. A registration granted to applicant would not limit applicant to presenting its mark in typed form; applicant would be free to use its registered mark in any particular format, including with design components similar to the ones in the cited registered marks. MSI Data Corp. v. Microprocessor Systems, Inc., 220 USPQ 655 (TTAB 1983).

Moreover, even if applicant's mark were limited to its typed form, all three of these marks are nonetheless similar because all three are dominated by the same

arbitrary term, "EQUATOR." The design elements in the cited registered marks are clearly less significant than the word portions of the marks. Consumers are likely to use the same term, "EQUATOR," when recommending or calling for any of these products. In summary as to this point, all three of these marks create similar commercial impressions in connection with the goods listed in the cited registrations and the application.

Turning, then, to the goods, we find that the Examining Attorney has established that consumers have reason to expect both luggage and small leather goods of the type specified in the application, on the one hand, and watches and items of clothing including ties and belts, on the other to emanate from the same commercial sources. Contrary to the argument made by applicant, the third-party use-based registrations submitted by the Examining Attorney listing the goods at issue in this appeal are evidence suggesting that the goods may be expected to emanate from a single source if they bear the same or similar trademarks. In re Mucky Duck Co., Inc., 6 USPQ2d 1467 (TTAB 1988); In re Albert Trostel and Sons Co., 29 USPQ2d 1783 (TTAB 1993).

Notwithstanding applicant's argument as to the differences in the actual prices the registrant charges for their products and the prices applicant actually charges

for its goods, the goods, as they are identified without limitation or restriction as to price or channels of trade in the respective registrations and the application, include relatively inexpensive items that could be sold in the same department stores to the same purchasers during the course of the same shopping trip.

Applicant argues that the existence of a number of registrations for the mark "EQUATOR" obviates any potential for confusion in this case. The du Pont case, *supra*, requires consideration of the number and nature of similar marks in use on similar goods, but the third-party registrations do not prove that the marks shown therein are actually in use. Only two of the registrations argued by applicant include goods related to the types of goods in the instant application, so even if the registrations were properly of record, they would not establish weakness of the term sought to the registered by applicant. Additionally, as the Examining Attorney points out, applicant's computer search report of information relating to registrations for unrelated goods was not accompanied by copies of the registrations, and therefore the registrations cannot even be considered to be properly of record. In *re Classic Beverages Inc.*, 6 USPQ2d 1383, (TTAB 1988).

In summary, we hold that confusion is likely in the instant case because the marks in question are very similar and the goods for which the cited marks are registered are related to the products on which applicant intends to use the mark it seeks to register.

Accordingly, the refusal to register under Section 2(d) of the Act is affirmed.

R. F. Cissel

T. J. Quinn

H. R. Wendel
Administrative Trademark Judges,
Trademark Trial and Appeal Board

Ser No. 75/209526